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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,644	04/17/2000	JOERG SCHWENK	2345/122	8596

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EXAMINER

DEMICO, MATTHEW R

ART UNIT PAPER NUMBER

2697

DATE MAILED: 04/25/2003

*g*

Please find below and/or attached an Office communication concerning this application or proceeding.

*g*

# Office Action Summary

Application No.

09/529,644

Applicant(s)

SCHWENK ET AL.

Examiner

Matthew R Demicco

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 22 and 24-29 is/are rejected.
- 7) ☒ Claim(s) 15, 17-21, 23 and 30-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 10/17/1997.

### ***Drawings***

2. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

### ***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14, 16, 22 and 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,978,649

Regarding Claim 14, Kahn discloses a method for routing data in a pay television terminal (See Figure 1, Direct Broadcast Satellite system), the data including receiving

rights (Col. 6, Lines 7-14) for a mobile data carrier (Col. 5, Line 8, "replaceable secured authorization card"). Kahn further discloses the transmission of the data from a transmitter (See Figure 1) via a transmission medium to the pay-TV terminal (Col. 3, Lines 61-65). The data is buffered at the terminal (Cols. 4-5, Lines 66-10).

Communication between the mobile data carrier and the terminal is established and the receiving data is routed and stored in the mobile data carrier (Col. 6, Lines 30-39).

Regarding Claim 16, Kahn discloses a method as stated above in Claim 14 wherein the mobile data carrier includes a chip-card (Col. 5, Line 8, "replaceable secured authorization card").

Regarding Claim 22, Kahn discloses a method as stated above in Claim 14 further comprising transmitting filter information (Col. 6, Lines 18-30) to the pay-TV terminal using the mobile data carrier upon establishing communication. It is inherent in such a system where authorization information is stored on a removable authorization card that the authorization information must be read by the terminal in order to for channel selection and tuning.

Regarding Claim 24, Kahn discloses a device for decoding pay-TV programs comprising control and evaluation electronics (See Figure 3, "microprocessor"), a communication apparatus for communicating with a first mobile data carrier via an interface (Col. 5, Line 8, "replaceable secured authorization card"), a memory for use as a list to buffer data transmitted from a transmitter to the device (Col. 6, Lines 18-30) via a transmission medium (See Figure 1) using the control and evaluation electronics, at least

a first portion of the buffered data being routed immediately to the first mobile data carrier (Col. 6, Lines 30-39).

Regarding Claim 25, Kahn discloses a device as stated above in Claim 24 further comprising a pay-TV terminal (See Figure 1, Direct Broadcast Satellite system and Figure 2, Terminal 38).

Regarding Claim 26, Kahn discloses a device as stated above in Claim 24 wherein the first mobile data carrier includes a chip-card (Col. 5, Line 8, "replaceable secured authorization card").

Regarding Claim 27, Kahn discloses a device as stated above in Claim 24 wherein the data includes receiving rights (Col. 6, Lines 7-30).

Regarding Claims 28 and 29, Kahn discloses a device as stated above in Claim 24 wherein the memory is a non-volatile EEPROM (Col. 5, Line 4).

#### ***Allowable Subject Matter***

6. Claims 15, 17-21, 23 and 30-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 5,534,857 to Laing et al. discloses a retailer smart-card system with remote data management and multiple sites with card readers performing authorization and remote data management.

b. U.S. Patent No. 5,144,663 to Kudelski et al. discloses a pay-television chip-card where credit balance is read and updated for purchases of on-demand programming.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

*mrd*

mrd  
April 21, 2003

*KAW Williams*

Kimberly A. Williams  
Primary Examiner  
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